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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,140	11/16/1999	BEKA SOLOMON	SOLOMONIREI	3910
1444	7590	01/11/2012		
Browdy and Neimark, PLLC 1625 K Street, N.W. Suite 1100 Washington, DC 20006			EXAMINER BALLARD, KIMBERLY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BEKA SOLOMON

Appeal 2011-009879
Application 09/441,140
Technology Center 1600

DECISION ON PETITION

This is a decision on the “PETITION UNDER 37 C.F.R. § 41.3,” filed November 9, 2011 (“Renewed Petition”). The Renewed Petition requests permission to file a supplemental reply brief in this case, which presents additional arguments not previously made in appellant’s main brief on appeal or reply brief and which, *inter alia*, requests that certain claims be considered separately from certain other claims. The supplemental reply brief to be filed upon acceptance of this petition is submitted herewith.

Renewed Petition, p. 2.

FINDINGS

- 1) On December 16, 1994, Petitioner filed Application 08/358,786.

- 2) On November 18, 1997, Application 08/358,786 issued as U.S. Patent 5,688,651.
- 3) On November 16, 1999, Petitioner filed the instant reissue application 09/441,140 with a preliminary amendment.
- 4) On September 5, 2000, a non-final rejection was mailed to Petitioner.
- 5) On January 8, 2001, Petitioner filed an amendment.
- 6) On June 29, 2001, a non-final rejection was mailed to Petitioner.
- 7) On December 31, 2001, Petitioner filed an amendment.
- 8) On June 21, 2002, Petitioner filed an amendment.
- 9) August 22, 2002, Petitioner filed a supplemental amendment.
- 10) On August 22, 2003, a final rejection was mailed to Petitioner.
- 11) On January 22, 2004, Petitioner filed a Notice of Appeal.
- 12) On February 23, 2004, Petitioner filed an amendment with a declaration under 37 C.F.R. §1.132.
- 13) On April 26, 2004, Petitioner filed a duplicate of the February 23, 2004 submission.
- 14) On June 10, 2004, a final rejection was mailed to Petitioner.
- 15) On August 9, 2004, Petitioner filed an amendment.
- 16) On August 18, 2004, Petitioner filed an amendment.
- 17) On August 25, 2004, Petitioner filed a supplemental amendment.
- 18) On September 10, 2004, a non-final rejection was mailed to Petitioner.
- 19) On March 17, 2005, Petitioner filed an amendment.
- 20) On July 29, 2005, a non-final rejection was mailed to Petitioner.
- 21) On January 17, 2006, Petitioner filed an amendment.
- 22) On June 2, 2006, a final rejection was mailed to Petitioner.

- 23) On August 2, 2006, Petitioner filed an amendment.
- 24) On September 19, 2006, a non-final rejection was mailed to Petitioner.
- 25) On March 19, 2007, Petitioner filed an amendment with four declarations under 37 C.F.R. §1.132.
- 26) On June 19, 2008, a final rejection was mailed to Petitioner.
- 27) On December 18, 2008, Petitioner filed an amendment with a declaration under 37 C.F.R. §1.132.
- 28) On March 23, 2009, a non-final rejection was mailed to Petitioner.
- 29) On September 23, 2009, Petitioner filed an amendment.
- 30) On December 10, 2009, a final rejection was mailed to Petitioner.
- 31) On May 10, 2010, Petitioner filed an amendment and a Notice of Appeal.
- 32) On November 10, 2010, Petitioner filed an Appeal Brief.
- 33) On March 30, 2011, an Examiner's Answer was mailed to Petitioner.
- 34) On May 31, 2011, Petitioner filed a 55 page Reply Brief and a request for oral hearing.
- 35) On June 15, 2011, an acknowledgement to the Reply Brief was mailed to Petitioner.
- 36) On October 27, 2011, Petitioner filed the instant Petition.

FACTS RELATED TO DIVISIONAL APPLICATION

- 37) On February 22, 2006, Petitioner filed a Divisional of the instant Application 09/441,140 as Application 11/358,951.
- 38) On September 20, 2006, a Restriction Requirement was mailed to Petitioner.

- 39) On December 20, 2006, Petitioner filed an election to the Restriction Requirement.
- 40) On February 12, 2007, a non-final rejection was mailed to Petitioner.
- 41) On June 12, 2007, Petitioner filed an amendment.
- 42) On July 26, 2007, a final rejection was mailed to Petitioner.
- 43) On January 28, 2008, Petitioner filed a Request for Continued Examination and an amendment.
- 44) On June 19, 2008, a non-final rejection was mailed to Petitioner.
- 45) On December 19, 2008, Petitioner filed an amendment.
- 46) On March 23, 2009, a final rejection was mailed to Petitioner.
- 47) On September 23, 2009, Petitioner filed a Notice of Appeal and an amendment.
- 48) On December 8, 2009, a non-final rejection was mailed to Petitioner.
- 49) On June 8, 2010, Petitioner filed an amendment.
- 50) On September 30, 2010, a final rejection was mailed to Petitioner.
- 51) On December 30, 2010, Petitioner filed a Notice of Appeal.
- 52) On June 30, 2011, Petitioner filed an Appeal Brief.
- 53) On August 22, 2011, an Examiner's Answer was mailed to Petitioner.
- 54) On October 24, 2011, Petitioner filed a 49 page Reply Brief and a request for oral hearing.

FACTS RELATED TO PETITION

- 55) On October 27, 2011, Petitioner filed a Petition Under 37 C.F.R. § 41.3 (Original Petition) seeking the same action as is sought by the present Renewed Petition, namely
permission to file a supplemental reply brief in this case, which presents additional arguments not previously made in appellant's main brief on appeal or reply brief and which, *inter alia*, requests that

certain claims be considered separately from certain other claims. The supplemental reply brief to be filed upon acceptance of this petition is submitted herewith.

Original Petition, p. 2.

- 56) The Supplemental Reply Brief inadvertently was not filed with the Original Petition. Renewed Petition, p. 2.
- 57) On November 8, 2011, in a Decision on Petition, the Original Petition was dismissed, citing the absence of any Supplemental Reply Brief. Decision, p. 5.
- 58) The Supplemental Reply Brief was filed with the Renewed Petition on November 9, 2011.

FACTS RELATED TO HEARING

- 59) A combined hearing for the appeals in the present and divisional applications is scheduled for February 2, 2012.

RELEVANT AUTHORITY

37 F.R. § 41.50 provides:

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. **The Board may also remand an application to the examiner.**

(emphasis added.)

37 C.F.R. § 41.41 states:

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

DISCUSSION

The Board formally acquired jurisdiction over this appeal on June 6, 2011 when it entered a BPAI Docketing Notice. Thus, presently, action by the Board is required to advance proceedings in this application.

The substance of Petitioner's argument urging that the Supplemental Reply Brief be accepted is that it addresses patentability issues that are relevant to the claims in the present application but which were first raised in the Examiner's Answer in the divisional application after briefing had been completed in the present application. The Examiner has not addressed those issues in the present application.

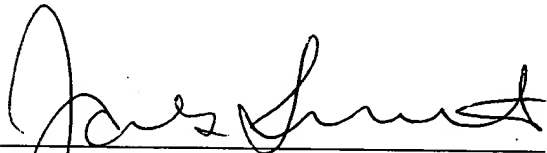
Further, since the patentability issues discussed in the Supplemental Reply Brief were briefed in the divisional application appeal, at the combined hearing for the appeals in the present and divisional applications, presently scheduled for February 2, 2012, the applicability of those issues to claims in the present application likely will arise without the Examiner ever having addressed

those issues on the record in the present application. Under these circumstances, the present application should be remanded to the Examiner for appropriate action, i.e., a supplemental examiner's answer. See MPEP § 1207.05.

DECISION

For the reasons set forth above, the Renewed Petition is GRANTED and the present application is remanded to the Examiner for consideration of and response to the Supplemental Reply Brief.

The combined hearing scheduled for February 2, 2012 is cancelled and will be rescheduled at an appropriate time in the future.

A handwritten signature in black ink, appearing to read 'James Smith', written over a horizontal line.

James Donald Smith
Chief Administrative Patent Judge

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